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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,421	12/08/2000	Robert E. Haines	10003228-1	2077

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

BRASE, SANDRA L

ART UNIT PAPER NUMBER

2852

DATE MAILED: 04/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,421

Applicant(s)

HAINES, ROBERT E.

Examiner

Sandra L. Brase

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7,9-14 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7,9-14 and 16-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 5, 12 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

On line 5 of claim 5, on line 7 of claim 12, and on line 6 of claim 19, "and" could be inserted before the word "low".

On lines 5-6 of claim 5, on lines 7-8 of claim 12, and on lines 6-7 of claim 19, the phrase "low or 'out of' status for other consumables or need for other maintenance items" is indefinite since it is unclear as to what is included by the terms "other consumables" and "other maintenance items", where the terms "other consumables" and "other maintenance items" are considered to be indefinite terms.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 3-6, 10-13 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawada et al. (US 5,715,496).

Sawada et al. (...496) disclose a method and apparatus of scheduling an event with respect to a hard copy output engine including: detecting a status of a portion of the hard copy output engine from a sensor, coupled to the portion, that detects and provides the status of the portion; composing an electronic message including the detected status; and transmitting the electronic message to a scheduling engine (col. 3, lines 38-54). A future need for preventive maintenance is detected (abstract; col. 3, lines 49-65; and col. 6, line 25 – col. 10, line 67). The electronic message includes malfunction and preventive maintenance items, and the detected status includes preventive maintenance alerts (col. 6, lines 25-44). The hard copy output engine can be a facsimile machine, a photocopier, or a printer (col. 10, lines 64-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 7, 9, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawada et al. (US 5,715,496) in view of Ohtani (US 6,108,099).

Sawada et al. (...496) disclose the features mentioned previously, but do not disclose detecting a toner out status, and the electronic message including a consumable order. Ohtani (...099) discloses a hard copy output engine including a sensor (11) that detects a toner out status

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(col. 4, lines 28-29). An electronic message including a consumable order is transmitted to an external device (col. 6, lines 27-36; col. 7, lines 37-47; and figures 6 and 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to detect a toner out status in order to determine that a toner supply needs to be replenished, and to have the electronic message include a consumable order so as to enable the ordering of a needed consumable, as disclosed by Ohtani (...099).

Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawada et al. (US 5,715,496) in view of Yamashita et al. (US 5,752,125).

Sawada et al. (...496) disclose the features mentioned previously, but do not disclose the maintenance including cleaning or replacement of a part. Yamashita et al. (...125) disclose maintenance of a hard copy output engine by a serviceman includes cleaning or replacement of a part (col. 6, lines 22-34). It would have been obvious to one of ordinary skill in the art at the time of the invention to include cleaning or replacement of a part during maintenance since such is well known in the art to occur during maintenance by a serviceman, as disclosed by Yamashita et al. (...125).

Response to Arguments

Applicant's arguments filed 11/14/01 have been fully considered but they are not persuasive.

Applicant argues claims 5, 12 and 19 are not indefinite. However, this is incorrect. The terms "other consumables" and "other maintenance items", which are contained in claims 5, 12

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and 19, are considered to be indefinite, thus rendering the claims 5, 12 and 19 indefinite. It is unclear as to what is encompassed by the term “other consumable” and by the term “other maintenance items”, thus the scope of the subject matter contained in each of claims 5, 12 and 19 is not clear. Therefore; the terms “other consumables” and “other maintenance items” are considered to be indefinite and thus make the scope of claims 5, 12 and 19 indefinite.

The argument by Applicant pertaining to the transitional phrases: comprising, consisting essentially of, and consisting of is considered to be irrelevant since no such rejection or objection was made in the previous or current office action pertaining to these terms.

Applicant argues that Sawada et al. (US 5,715,496) do not disclose preventive maintenance. However, this is incorrect. Sawada et al. (...496) disclose a predictor for predicting the future occurrence of an error, thus determining when a visit by a serviceman is necessary, sending a message for need of a serviceman visit before such an error occurs so that maintenance can be performed by a visit by the serviceman before such an error occurs, thus the maintenance performed by the serviceman prevents an error, thus is preventive maintenance (abstract; col. 3, lines 49-65; and col. 6, lines 25 – col. 10, line 67). Applicant is to note, on page 5, lines 11-14 of their specification, it is described that a device determines when preventative maintenance is to occur where this device predicts when a visit by a serviceman is necessary, which is similar to the predictor of Sawada et al. (...496). As a result, Sawada et al. (...496) do disclose detecting a future need for preventive maintenance.

Final Rejection

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contacts \ Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra L. Brase whose telephone number is (703) 308-0725.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur T. Grimley, can be reached on (703) 308-1373. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3431 or 305-3432.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Sandra L. Brase
Primary Examiner
Art Unit 2852

April 17, 2002